



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JOSEPH J. MAYO
DALINA LAW GROUP, P.C.
7910 IVANHOE AVE. #325
LA JOLLA, CA 92037

MAILED
NOV 19 2004
Technology Center 2100

In re Application of: Lowe
Application No. 10/605,527
Filed: October 6, 2003
For: METHOD AND APPARATUS FOR
GENERATING AND DISTRIBUTING
PERSONALIZED MEDIA CLIPS

DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)

This is a response to the petition filed October 9, 2004, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 (VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **DISMISSED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, **or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;**
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;

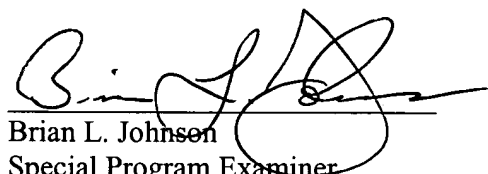
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petition filed October 9, 2004 fails to adequately meet requirements (b), (d) and (e) of the criteria set forth above. With respect to requirement (b), Petitioners fail to indicate that if the Office determines that all of the claims presented are not obviously directed to a single invention, an election will be made without traverse **as a prerequisite** to the grant of special status. Such statement is missing from the instant petition and required for the grant of special status. With respect to requirement (d), the petition fails to provide identification in the form of listing of all references deemed to be most closely related to the subject matter encompassed by the claims. Specifically, petitioner has failed to provide a listing as set forth in M.P.E.P. 609 and 37 CFR §1.98 (e.g. PTO form 1449). With respect to requirement (e), a complete detailed discussion of the (aforementioned most closely related) references has not been provided with the necessary specificity required under 37 CFR 1.111 (b) and (c). Petitioner should ensure that the above discussion is directed to how the language of *each of* the independent claims is specifically distinguishable and patentable from the references provided in requirement (d) above. Reference is made to independent claim 54.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.



Brian L. Johnson
Special Program Examiner
Technology Center 2100
Computer Architecture, Software and Information Security
703-308-0885